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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,473	04/21/2004	Hiroya Fukuyama	12706/13	5144
23838	7590	04/17/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			FINEMAN, LEE A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/828,473

Applicant(s)

FUKUYAMA ET AL.

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/21/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Species X (fig. 24) in the reply filed on 25 January 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-9 and 13-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

### *Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

3. Claims 11 and 12 are objected to because of the following informalities:

Claim 11 includes the limitation "a **second** laser light irradiation device" and claim 12 includes the limitation "a **third** microscope holding member," which imply that there are a first laser and a first and second holding member. However, the claims do not include these features. The examiner recommends removing these sequential descriptors to prevent confusion in what is

Art Unit: 2872

actually part of the claimed invention. For the purposes of examination only one laser and one holding member are considered claimed. Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Prinzhausen et al., US 6,940,610.

Prinzhausen et al. disclose in fig. 1 a microscopic observing apparatus comprising: a probe microscope (E); an auxiliary microscope (confocal microscope, see column 6, lines 20-22); a specimen stage (BE) on which is placed a subject (O) of observation that is to be observed using the probe microscope and the auxiliary microscope (fig. 1), and that allows an absolute position of the subject of observation to be adjusted (column 6, lines 59-62); and a second laser light irradiation device (LQ, column 6, lines 43-44) that irradiates laser light that is coaxial with the optical axis of the probe microscope onto the subject of observation (fig. 1), wherein the auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible (fig. 1).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumanuma et al., US 5,742,429 in view of Prinzhausen et al.

Tsumanuma et al. disclose a microscopic observing apparatus (see, e.g., fig. 4) comprising: a probe microscope (apparatus with 13, 17, 21, 22); an auxiliary microscope (apparatus with 12, 14, 8, 11); and a second light irradiation device (21, 22, 23 see figs. 2 and 3) that irradiates light that is coaxial with the optical axis of the probe microscope onto the subject (Sm, Sf) of observation (fig. 1), wherein the auxiliary microscope is located such that the light irradiated onto the subject of observation is visible (fig. 4, fig. 6); wherein the auxiliary microscope is a video microscope including a camera (column 7, lines 34-36) with a macro lens (in so far as the images from the auxiliary microscope are of a lower magnification than those from the probe microscope (see fig. 6), and that is held together with the probe microscope by a third microscope holding member (18, see especially figs. 9 and 10). Tsumanuma et al. disclose the claimed invention except for explicitly stating a specimen stage on which is placed a subject of observation that is to be observed using the probe microscope and the auxiliary microscope that allows an absolute position of the subject of observation to be adjusted; the light source being a laser; and the camera being a CCD camera. Prinzhausen et al. teach a microscopic observing apparatus comprising: a probe microscope (E); an auxiliary microscope (confocal

Art Unit: 2872

microscope, see column 6, lines 20-22) which includes a specimen stage (BE) on which is placed a subject (O) of observation that is to be observed using the probe microscope and the auxiliary microscope (fig. 1), and that allows an absolute position of the subject of observation to be adjusted (column 6, lines 59-62); a laser light source (LQ, column 6, lines 43-44); and a CCD camera (BA, column 6, line 58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the stage of Prinzhausen et al. to the system of Tsumanuma et al. to be able to more accurately and precisely move the specimen/subject for different imaging views. Further it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the light source of Tsumanuma et al. a laser light source as taught by Prinzhausen et al. to be able to examine specific specimen/subject characteristics. Finally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the TV camera of Tsumanuma et al. a CCD camera as taught by Prinzhausen et al. as it is a commonly available and easily to obtain type of camera.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leon, et al., US 5,095,887; Nakamura et al., US 6,398,721 B1; Nakanishi et al., US 2003/0069471 A1; Shioda et al., US 6,081,371; Nakatate et al., WO 00/71046 A1; Shioda et al., JP08131456 A; Nakanishi et al., JP2001299695 A; and Kudo et al., JP2001198141 A all disclose microscopic observing apparatus with a probe microscope and an auxiliary microscope.

Art Unit: 2872

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF

April 12, 2006



MARK A. ROBINSON  
PRIMARY EXAMINER